

REMARKS

Favorable reconsideration of the present patent application is respectfully requested in view of the foregoing amendments and the following remarks.

In this Amendment claims 1, 13 and 18 are amended, claims 46-51 are added, and no claims are canceled (claims 31, 38, 40, 42 and 44 were previously canceled). As a result, claims 1-30, 32-37, 39, 41, 43 and 45-51 are now pending in the application. Support for the newly added claims and claim amendments can be found throughout the disclosure, for example, at pages 6-7, 9-10 and 13, and Figures 2 and 6.

In the non-final Office Action of July 27, 2007, claim 18 is objected to for an antecedent basis issue. Claims 1-10, 13-25, 27, 29-30, 32 and 34-36 are rejected under 35 U.S.C. §103(a) in view of U.S. Patent 6,314,189 (Frederick) further in view of U.S. Patent 5,257,348 (Roskowski) and yet further in view of U.S. Patent 5,287,189 (Ersoz).

Claim Objection

This paper includes an amendment to claim 18 that attends to the objection. Accordingly, withdrawal of the objection is respectfully requested.

Frederick / Roskowski / Ersoz §103 Rejection

The §103 rejection of claims 1-10, 12-25, 27-30 and 32-37 in view of the hypothetical combination of Frederick, Roskowski and Ersoz is respectfully traversed, for at least the following reasons. Although the amendments to independent claims 1 and 13 obviate the

rejections of these claims, it is noted that independent claims 29 and 34 have not been amended herein, and thus, should not be subject to rejection for at least the following reasons.

Regarding the microprocessor recited in claim 13, it is noted that the Office Action points to col. 5, lines 46-49 of the Frederick patent, contending that the Frederick system has a display apparatus that includes a microprocessor. (It is believed that the Office intends this to apply to claims 29 and 34 as well, based on the mention of these claims at page 7 of the Office Action.) This cited passage mentions that the PC 14 and display 12 of Frederick support the USB Monitor Control Class specification and VESA Monitor Control Command Set. However, this cited passage does not mention any microprocessor of the display apparatus. It is believed that neither this passage, nor any other passage of Frederick, discloses any microprocessor of the display device, let alone the microprocessor with the features recited in the pending claims. Even if one believed that the Frederick display device includes a microprocessor, there is nothing to instruct one of ordinary skill in the art that such an assumed microprocessor would be capable of “comprising control logic for controlling a television feature of the display apparatus from the host computer system when said screen is operating in said interlaced format, and for enabling an overlay window” as recited in claim 34, since, as discussed below, the display screen of Frederick is incapable of displaying both interlaced and noninterlaced video.

In the event the rejection is maintained, it is respectfully requested that the next paper explain how the Frederick patent is being construed to teach a display apparatus comprising “a microprocessor for receiving commands from said host computer system, said microprocessor comprising control logic for controlling a television feature of the display apparatus from the host

computer system when said screen is operating in said interlaced format, and for enabling an overlay window” as recited in claim 34, or the similar features recited in other pending claims.

The Office Action notes that the first cited document, the Frederick patent, fails to teach a number of elements of the pending claims, including: a processor, a memory coupled to the processor, a video controller coupled to the memory and the processor, a display controller, and a display screen. The Office Action then contends that it is inherent that the Frederick system would include all of these elements. The inherency of some of these elements is respectfully traversed (see next section).

The Office Action contends that Frederick teaches a display screen in accordance with the present invention. The pending claims include a “screen, said screen operable to display visually detectable output from the host computer system when operating in the noninterlaced mode of operation and operable to display the converted television output in an overlay window while said visually detectable output from the host computer system is being displayed in the noninterlaced mode of operation,” as recited in claim 34 (and the similar features of claims 1 and 13), and the feature of a “display apparatus comprising circuitry providing a first mode of operation which is an interlaced mode of operation and a second mode of operation which is a noninterlaced mode of operation” as recited in claim 29. It is respectfully submitted that the Office Action’s contention that Frederick includes these features cannot be maintained. The Frederick patent is silent as to whether its system supports both an interlaced mode and a non-interlaced mode. The Frederick patent does, however, discuss using either an analog display or else a digital display. That is, the Frederick system can operate either with an analog display, or with a digital display, but does not teach a single display, or display circuitry, having both modes

of operation. In fact, the Frederick patent appears to teach away from this feature, stating that the signals for the display are different depending upon the type of display. The Frederick patent goes on to say that an analog display supports the signals listed in Table 4, while a digital display supports the signals displayed in Table 5. Hence, the Frederick patent does not teach the features mentioned above pertaining to a noninterlaced mode and an interlaced mode. It appears that the Frederick patent teaches away from these features since the Frederick system provides either an analog monitor or else a digital monitor, depending upon the type of signal being sent.

Regarding the features mentioned above pertaining to a noninterlaced mode and an interlaced mode, the secondarily cited document, the Roskowski patent, appears more relevant than the Frederick patent. The Roskowski patent involves a computer system that displays either video or graphic information on a display. However, the Frederick patent teaches away from being modified to include features of the Roskowski system. According to MPEP §2143.01 it is improper to combine references where the references teach away from their combination. MPEP §2143.01 requires that, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”¹ Since Frederick expressly states that “[t]he signals for the display 12 are different depending upon the type of display,”² it would render the Frederick system unsatisfactory for its intended operation to modify it to operate in a manner similar to Roskowski. Instead of having a display capable of displaying both interlaced and noninterlaced signals, the Frederick device operates by providing the correct type of signal to the display device

¹ MPEP §2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

² Frederick, col. 7, lines 52-53.

depending upon the type of display device being used. Consequently, it would be improper to combine Frederick with Roskowski.

Turning to the third cited document in the rejection, the Ersoz patent, this patent, like Roskowski, involves interlaced signals and non-interlaced signals. However, for the same reasons set forth above, it would be improper to combine Ersoz with the Frederick because doing so would make Frederick unsatisfactory for its intended purpose.

For at least these reasons, the hypothetical combination of Frederick, Roskowski and Ersoz does not teach or suggest teaches a “screen, said screen operable to display visually detectable output from the host computer system when operating in the noninterlaced mode of operation and operable to display the converted television output in an overlay window while said visually detectable output from the host computer system is being displayed in the noninterlaced mode of operation,” as recited in claim 34 (or the similar features of claims 1 and 13), and the feature of a “display apparatus comprising circuitry providing a first mode of operation which is an interlaced mode of operation and a second mode of operation which is a noninterlaced mode of operation” as recited in claim 29.

Accordingly, it is respectfully submitted that the Frederick, Roskowski and Ersoz patents, either taken singly or in hypothetical combination, do not teach the features of the claimed invention. Therefore, withdrawal of the §103 rejection applied to claims 1-10, 12-25, 27-30 and 32-37 is respectfully requested.

Traversal of Inherency Allegation of Frederick Patent

MPEP §2112 provides guidelines for a feature to properly be considered inherent. MPEP §2112 states, in part:

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”³

“The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”⁴

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”⁵

In accordance with the standards for inherency set forth in MPEP §2112, it is respectfully submitted that a number of the features alleged to be inherent in the Office Action cannot be properly maintained.

In the §103 rejections citing the Frederick patent, the Office Action contends that several claim elements are inherent in Frederick, including the processor, the memory coupled to the processor, the video controller coupled to the memory and the processor, the display controller, and the display screen, in addition to the features of these elements recited in the claims. These contentions are traversed, and in particular, the contentions of inherency discussed below are traversed for at least the following reasons.

The Office Action states that “it is inherent that Frederick has a display controller as the PC 14 and the display 12 supports two different viewing modes where one mode is configured

³ MPEP §2112 citing In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

⁴ MPEP §2112 citing In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

⁵ MPEP §2112 citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

for displaying PC graphics and the other mode is configured for displaying TV video.”⁶ It is respectfully submitted that this feature is not inherent in Frederick. In fact, as discussed above, the Frederick patent appears to teach away from this feature. The Frederick patent expressly states that “[t]he signals for the display 12 are different depending upon the type of display.”⁷ Rather than having a single display with two different modes, the Frederick system simply provides the type of signals compatible to the particular display being used. If an analog display is being used, the Frederick system provides one of the signals from Table 4. If a digital display is being used, the Frederick system provides one of the signals from Table 5. Thus, the aforementioned claim features are not inherent in the Frederick system. For these same reasons, it is not inherent for the Frederick system “to display visually detectable output from the host computer system when operating in the noninterlaced mode of operation and operable to display the converted television output in an overlay window while said visually detectable output from the host computer system is being displayed in the noninterlaced mode of operation,” as recited in claim 34, or the similar features recited in claims 1 and 13.

Frederick / Roskowski / Newman §103 Rejection

The §103 rejection of claims 11 and 26 in view of the hypothetical combination of Frederick, Roskowski and Newman is respectfully traversed, for at least the following reasons.

The remarks above pertaining to the deficiencies of the Frederick and Roskowski patents are hereby incorporated into the discussion of the §103 rejection of claims 11 and 26.

⁶ Office Action of July 27, 2007, at page 3.

⁷ Frederick, col. 7, lines 52-53.

In the §103 rejection of claims 11 and 26 the third cited Newman patent is relied upon to allegedly teach a parallel port. The Newman patent involves a non-linear editing system for home audio and video applications. Regardless of whether the Newman patent actually does teach a command being sent over a parallel port, it is respectfully submitted that Newman does not pertain to either a display or a computer system that has a noninterlaced mode of operation and an interlaced mode of operation. Therefore, the Newman patent does not overcome the deficiencies of the hypothetical combination of Frederick and Roskowski, as discussed above in regard to the other §103 rejection.

Accordingly, it is respectfully submitted that Frederick, Roskowski and Newman, either taken singly or in hypothetical combination, do not teach or suggest the features of the claimed invention. Therefore, withdrawal of the §103 rejection of claims 11 and 26 is respectfully requested.

Deposit Account Authorization / Provisional Time Extension Petition

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-0439 and please credit any excess fees to such deposit account.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. However, in the event there are any unresolved issues, the Examiner is kindly invited to contact applicant's representative, Scott Richardson, by telephone at (571) 970-6835 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

A handwritten signature in cursive script, reading "Scott Charles Richardson".

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